

### **REMARKS:**

Claims 1 to 19 are pending in the present application.

It is respectfully submitted that the following remarks present no new issues or new matter and places this case in condition for allowance. Reconsideration and withdrawal of the outstanding rejections is respectfully requested.

#### **1. Rejection of Claim 19 under 35 U.S.C. § 101, Double Patenting**

Claim 19 was rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 19 of prior U.S. Patent No. 6,291,523. Applicants respectfully traverse this rejection.

Claim 19 of the present application is directed to a method for the preparation of a compound of formula I according to claim 1 which comprises a number of process steps. Claim 19 of U.S. Patent No. 6,291,523 is directed to a method according to claim 17 (a method of selectively inhibiting cyclooxygenases-2 activity). Accordingly, since claim 19 of the present applications is directed to a process of making compounds and claim 19 of US 6,291,523 is directed to a method of selectively inhibiting enzyme activity, the two claims do not claim the same invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. §101 based on claim 19 of U.S. 6,291,523.

#### **II. Rejection of Claims 1 to 18 under the Judicially Created Doctrine of Obviousness-type Double Patenting**

Claims 1 to 18 were rejected for obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,310,099. As indicated in the Office Action, the conflicting claims are not identical.

Applicants agree with the Examiner that the conflicting claims are not identical. In order to advance prosecution and place this case in condition for allowance, Applicants believe that the attached terminal disclaimer filed in compliance with 37 CFR 1.321(c) overcomes this obviousness-type double patenting rejection.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection based on U.S. 6,310,099.

**III. Rejection of Claims 1 to 18 under the Judicially Created Doctrine of Obviousness-type Double Patenting**

Claims 1 to 18 were rejected for obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,451,858. As indicated in the Office Action, the conflicting claims are not identical.

Applicants agree with the Examiner that the conflicting claims are not identical. In order to advance prosecution and place this case in condition for allowance, Applicants believe that the attached terminal disclaimer filed in compliance with 37 CFR 1.321(c) overcomes this obviousness-type double patenting rejection.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection based on U.S. 6,451,858.

**IV. Rejection of Claims 1 to 19 under the Judicially Created Doctrine of Obviousness-type Double Patenting**

Claims 1 to 18 were rejected for obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,727,281. As indicated in the Office Action, the conflicting claims are not identical.

Applicants agree with the Examiner that the conflicting claims are not identical. In order to advance prosecution and place this case in condition for allowance, Applicants believe that the attached terminal disclaimer filed in compliance with 37 CFR 1.321(c) overcomes this obviousness-type double patenting rejection.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection based on U.S. 6,727,281.

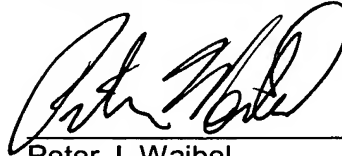
**V. Rejection of Claims 1 to 18 under the Judicially Created Doctrine of Obviousness-type Double Patenting**

Claims 1 to 18 were rejected for obviousness-type double patenting as being unpatentable over claims 17-36 of US Patent No. 6,291,523. As indicated in the Office Action, the conflicting claims are not identical.

Applicants agree with the Examiner that the conflicting claims are not identical. In order to advance prosecution and place this case in condition for allowance, Applicants believe that the attached terminal disclaimer filed in compliance with 37 CFR 1.321(c) overcomes this obviousness-type double patenting rejection.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection based on US 6,291,523.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter J. Waibel", is written over a horizontal line.

Peter J. Waibel  
Attorney for Applicants  
Reg. No. 43,228

Novartis  
Corporate Intellectual Property  
One Health Plaza, Building 104  
East Hanover, NJ 07936-1080  
(862) 778-7951

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